



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant: John L. Tetenes § Series Code/Serial No.: 10/027,358
Invention: DEVICE FOR HOLDING § Filed: December 26, 2001
A BUCKET OF FRESH CHUM § Group Art Unit: 3643
Agent's Docket No.: TETJ13A § Examiner: David J. Parsley
Doc. Loc. N\WP51\AMEN001C\TETJ13A11.WPD § Paper No.: 11

As article No.: EL586865107US EXPRESS MAIL I hereby certify, that on the below indicated date, this correspondence is being deposited with the United States Postal Service with sufficient postage in an envelope addressed to the: Commissioner for Patents, ALEXANDRIA, P.O. BOX 1450, VA 22313-1450.

MS AF (PATS)
Commissioner for Patents
P.O. BOX 145
ALEXANDRIA, VA 22313-1450

BY: Richard L. Miller
Agent for Appellant
Date: March 23, 2006

John L. Tetenes' Brief on Appeal

Sir:

1. Introductory Comments.

Appellant appeals from the Final rejection of pending claims 1 and 4 and files the instant Brief on Appeal in triplicate. Attached is Applicant's Check No.:2830 drawn on JPMorgan Chase Bank in the amount of \$250.00 to cover the required fee for submission of appellant's brief on appeal.

RICHARD L. MILLER
12 Parkside Drive
Dix Hills, NY 11746-4879

RESPECTFULLY SUBMITTED

Richard L. Miller
Richard L. Miller, Reg. # 26,309
Agent for Appellant

03/27/2006 AKELECH1 00000053 10027358

01 FC:2402

250.00 OP

Table of Contents

| | |
|--|----|
| Introduction | 3 |
| Real Party in Interest | 5 |
| Related Appeals and Interferences | 5 |
| Status of Claims | 5 |
| Status of Amendments | 5 |
| Summary of Invention | 6 |
| Claim 1 - the Only Independent Claim on File | 6 |
| Claim 4 - the Only Dependent Claim on File | 9 |
| Issues | 9 |
| Issue I | 9 |
| Grouping of Claims | 9 |
| Arguments | 9 |
| Issue I | 9 |
| Conclusions | 25 |
| Table of Authorities | 28 |
| Appendix | 31 |

2. Introduction.

Common law is a source of law that represents a pillar upon which our legal system rests. Common law began in 12th century England as unwritten law, reflecting “common” customs.

By the 17th century, common law began being written down from judges, deciding actual cases, based on decisions of the past, and came to be dubbed “decisional law” or “case law.” Common law looks to the past, evolving new rules by adapting old ones.

Describing where common law came from, Oliver Wendell Holmes, Jr. wrote:

“A very common phenomenon, and one very familiar to the student of history, is this. The customs, beliefs, or needs of a primitive time establish a rule or a formula. In the course of centuries the custom, belief, or necessity disappears, but the rule remains.”

Common law are rules of law, organically grown, as if following Darwin’s principle of natural selection. Useful laws are used again and become part of the common law, to serve as the foundation for further refinements, and useless laws are forgotten.

Common law is judge-made law. Each time a case is decided, it is added to the folk law that is the common law. The important decisions are relied upon and serve as precedents that are used to decide future cases.

A disadvantage of the concept of precedent, however, is that the law is slow to change with changing times, but when it does, it is well received.

Precedent is the soul of common law. It exists as folk law, passed on from written decision to written decision, much as our tribal ancestors passed on knowledge by word of

mouth. It is this decisional law that appellant relies upon in support of his arguments presented below in the instant Brief On Appeal.

3. Real Party in Interest.

The party identified in the caption of the instant brief is the real party in interest pursuant to 37 CFR § 1.192(c)(1).

4. Related Appeals and Interferences.

There are no appeals or interferences known to applicant's legal representative or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in pending appeals pursuant to 37 CFR § 1.192(c)(2).

5. Status of Claims.

Claims 1 and 4 now pending in the application have been finally rejected and are on appeal. Claims 2, 3, and 5-9 have been canceled and claims 10 and 11 have been withdrawn.

6. Status of Amendments.

No amendment has been filed subsequent to the Final rejection.

7. Summary of Invention.

A. Claim 1 - the Only Independent Claim on File.

A device (10) for holding a bucket (12) of chum (14) submerged in water (16)

[*Page 7, lines 4-5; and FIG. 2*], comprising:

- a) a cylindrical containing component (18) [*Page 7, line 5; and FIG. 2*]
having a lower edge (22) and an upper edge (26) [*FIG. 7*];
- b) a circular bottom component (20) being permanently attached to said lower edge (22) of said cylindrical containing component (18) [*Page 7, lines 6-7; and FIG. 7*];
- c) a toroidal sleeve (24) being fixedly located near said upper edge (26) of said cylindrical containing component (18) [*Page 7, lines 7-8; and FIG. 7*];
- d) a drawstring (28) cooperating with said upper edge (26) of said cylindrical containing component (18) and pulling said upper edge (26) closed for captivating the bucket (12) of chum (14) held within said device (10) [*Page 7, lines 9-11; and FIG. 7*]; and
- e) a welting (54) [*Page 8, line 11*] having edges (60) [*Page 8, line 12; and FIG. 8*];

wherein said cylindrical containing component (18) is fabricated out of sheet material (18a) [Page 7, lines 12-13; and FIG. 3];

wherein said sheet material (18a) is rectangular and has an upper edge (26a), a lower edge (22a), and two side edges (32) [Page 7, lines 13-15; and FIG. 3];

wherein said upper edge (26a) of said sheet material (18a) is said upper edge (26) of said cylindrical containing component (18) [Page 7, lines 15-17; and FIG. 3];

wherein said lower edge (22a) of said sheet material (18a) is said lower edge (22) of said cylindrical containing component (18) [Page 7, lines 17-19; and FIG. 3];

wherein said sheet material (18a) has two side edges (32) that are stitched together [Page 7, lines 21-22; and FIG. 3];

wherein said sheet material (18) has a first plurality of orifices (36) therein for permitting chum matter (14) to passthrough [Page 7, lines 22-24; FIGS. 1, 3, and 7];

wherein said sheet material (18a) has a second plurality of orifices (38) inline therein for cooperating with said drawstring (28) that is threaded therethrough [Page 7, lines 24-26; and FIG. 3];

wherein said sheet material (18a) has a longitudinal area (40) extending between said first plurality of orifices (36) and said second plurality of orifices (38), fabricates said toroidal sleeve (24) [Page 7, lines 26-29; and FIGS. 2, 3, and 7],

and has a first longitudinal edge (42a) and a second longitudinal edge (44a) [FIG. 7];

wherein said toroidal sleeve (24) is fabricated by attaching said first longitudinal edge (42a) of said longitudinal area (40) and said second longitudinal edge (44a) of said longitudinal area (40) together [Page 7, line 30 to page 8, line 2; and FIG. 3];

wherein said sheet material (18a) is flexible plastic material [Page 8, lines 16-19];

wherein said circular bottom component (20) is fabricated out of sheet material having at least one orifice (36) therein for permitting the chum matter (14) to pass through [Page 8, lines 4-6; and FIG 6];

wherein said circular bottom component (20) has a circumference (50) and is permanently attached by stitching (48) near said circumference (50) thereof and near said lower edge (22) of said cylindrical containing component (18) [Page 8, lines 6-9; and FIG. 6];

wherein said edges (60) of said welting (54) are sewn in between said circumference (50) of said circular bottom component (20) and said lower edge (22) of said cylindrical containing component (18) [Page 8, lines 12-15; and FIG. 8]; and

wherein said sheet material is flexible plastic material [Page 8, lines 16-19].

B. Claim 4 - the Only Dependent Claim on File.

The device (10) as defined in claim 1, wherein said toroidal sleeve (24) has foam floatation element (46) housed therein [*Page 8, lines 2-3; and FIGS. 2, 4, and 7*].

8. Issues.

A. Issue I.

Whether claims 1 and 4 are unpatentable under *35 U.S.C. § 103(a)* over Tetenes in view of Nelson *et al.* Levey in view of Campbell in view of Juergens in view of Roberts and Willinger.

9. Grouping of Claims.

The claims on appeal do not stand or fall together and are separately patentable.

10. Arguments.

A. Issue I.

Whether claims 1 and 4 are unpatentable under *35 U.S.C. § 103(a)* over Tetenes in view of Nelson *et al.* Levey in view of Campbell in view of Juergens in view of Roberts and Willinger.

Tetenes respectfully draws the Board's attention to the fact that the Federal Circuit holds that relevant case law must be relied upon in determining obviousness — the determination of obviousness is a matter of law as decided in *In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ.2d (BNA) 1210, 1214 (Fed. Cir. 1995), where the Court held:

“Obviousness is a question of law, which we review de novo, though factual findings underlying the Board's obviousness determination are reviewed for clear error. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *In re Woodruff*, 919 F.2d 1575, 1577, 16 USPQ2d 1934, 1935 (Fed. Cir. 1990).”[at 1214][Emphasis added]

And, in *Richardson-Vicks Inc. v. The Upjohn Co.*, 122 F.3d 1476, 44 USPQ.2d 1181 (Fed. Cir. 1997), where the Court held:

“The difficulty with RVI's position is that, although the argument has merit when the issue is purely one of fact, it does not follow when the issue involves a question of law. It is black letter law that the ultimate question of obviousness is a question of law. See *Graham v. Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966) (citing *Great A. & P. Tea Co.*

v. Supermarket Equip. Co.,
340 U.S. 147, 155, 87 USPQ
303, 309 (1950)); *In re*
Donaldson Co., 16 F.3d
1189, 1192, 29 USPQ2d
1845, 1848 (Fed. Cir. 1994)
(en banc); *Texas Instruments*
Inc. v. Unit States Int'l Trade
Comm'n, 988 F.2d 1165,
1178, 26 USPQ2d 1018,
1028 (Fed. Cir. 1993). And
we review that legal question
without deference to the trial
court. *See Gardner V. TEC*
Sys. Inc., 725 F.2d 1338,
1344, 220 USPQ 777, 782
(Fed. Cir. 1984) (district
court's conclusion on
obviousness "is one of law
and subject to full and
independent review in this
court")."[at 1183][Emphasis
added]

In the seminal case of *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467, 15 L.Ed. 2d 545, 86 S. Ct. 684 (1966), the Supreme Court articulated the requirements for a *prima facie* holding of obviousness. The Patent Office has since set forth in *MPEP* § 706.02 a three step requirement for establishing a *prima facie* case of obviousness.

The first step requires that the Examiner must set forth the differences in the claim over the applied references. The second step requires that the Examiner must set forth the proposed modification of the reference which would be necessary to arrive at the claimed

subject matter. And, the third step requires that the Examiner must explain why the proposed modification would be obvious.

The Courts require that in order to satisfy the third step for establishing a *prima facie* case of obviousness, the Examiner must identify where the prior art provides a motivating suggestion to make the modifications proposed in the second step for establishing a *prima facie* case of obviousness as expressed in the 1992 Federal Circuit Court decision in *In re Jones*, 958, F.2d 347, 21 USPQ.2d 1941, where the Court held:

“Contention that one skilled in the herbicidal art would have been motivated to use, with acid commonly known as “dicamba,” substituted ammonium salt such as that disclosed in two prior references does not warrant holding that claimed substituted ammonium salt of dicamba for use as herbicide is prima facie obvious, since there is no suggestion for combining disclosures of those references either in references themselves, which are directed to shampoo additives and production of morpholine, respectively, or in knowledge generally available to those skilled in the art.”[at 1941][Emphasis added]; and

“The Solicitor points out that, given the breadth of forms of dicamba (free acid, ester, or salt) disclosed by Richter as having herbicidal utility, one of ordinary skill in the art would appreciate that the dicamba group has significance with respect to imparting herbicidal activity to dicamba compounds. Thus, the solicitor contends, one skilled in the art would have been motivated to uses, with dicamba, substituted ammonium salts made from a known amine, such as the amine disclosed by Zorayan and Wideman, and would have expected such a salt to have herbicidal activity. Before the PTO may combine the disclosures of two or more prior art references in order to establish prima facie obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598-99 (Fed. Cir. 1988). We see no such suggestion in Zorayan, which is directed to shampoo additives, nor Wideman, which teaches that the amine used to make the

claimed compound is a
byproduct of the production
of morpholine. Nor does the
board disclosure of Richter
fill the gap, for the reasons
discussed above.”[at
1943][Emphasis added]

And, in *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 912 F.Supp. 422, 38

USPQ.2d 1300 (W.D.Ark. 1996), where the Court held:

“The existence of separate
elements of the invention in
the prior art is insufficient to
establish obviousness, absent
some teaching or suggestion
in the prior art to combine the
elements.”[Emphasis added]

And, in *Gambro Lundia AB v. Baxter Healthcare Corporation*, 110 F.3d 1573, 42

USPQ.2d 1378 (Fed. Cir. 1997), where the court held:

“Without a suggestion or
teaching to combine, a case of
obviousness is deficient.”
[Emphasis added]

The Courts further require, however, that even if the prior art may be modified as suggested by the Examiner, the modification is not made obvious unless the prior art suggests the desirability of the modification as expressed in the 1992 Federal Circuit Court decision in *In re Fritch*, 922, F.2d 1260, 23 USPQ.2d 1780, where the Court held:

“Mere fact that prior art may
be modified to reflect features

of claimed invention does not make modification, and hence claimed invention, obvious unless desirability of such modification is suggested by prior art * * *.”[at 1780][Emphasis added]; and

“The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 733 F.2d at 902, 221 USPQ at 1127.”[at 1783][Emphasis added]

And further, the *Fritch* Court at 1783, held that the patent applicant may attack the Examiner's prima facie determination as improperly made out and tending to support a conclusion of nonobviousness:

“In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. * * * [The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would

lead to that individual to combine the relevant teachings of the references. The patent applicant may then attack the Examiner's prima facie determination as improperly made out, or the applicant may present objective evidence tending to support a conclusion of nonobviousness.”[Emphasis added]

In this same regard, the Board's attention is respectfully drawn to the decisions in *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, 21 F.3d 1068, 30 USPQ.2d 1377; *In re Fine*, 837 F.2d 1071, 5 USPQ.2d 1596 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In properly applying the *Graham v. John Deere Co.* test in light of *In re Jones* and *In re Fritch* discussed above, the Examiner must conduct a rigorous examination and analysis of the prior art. It would appear that the Examiner has not done so.

Neither Tetenes, Nelson *et al.*, Levey, Campbell, Juergens, Roberts, Willinger, nor for that matter any of the other references cited by the Examiner, make any motivating suggestion that, *inter alia*:

- The device for holding a bucket of chum as taught by Tetenes can be modified to have added thereto the drawstring to close the upper edge of the container as

taught by Nelson *et al.*, as suggested by the Examiner at page 3, ¶ 1, lines 6-8 of the Final Rejection;

- The device for holding a bucket of chum as taught by Tetenes and modified by Nelson *et al.* can be further modified to have added thereto the sheet material having a plurality of orifices for permitting chum matter to pas through as taught by Levey, as suggested by the Examiner at page 4, ¶ 1, lines 4-6 of the Final Rejection;
- The device for holding a bucket of chum as taught by Tetenes and modified by Nelson *et al.* can be further modified to have added thereto the sheet material having a second plurality of orifices to thread the drawstring as taught by Campbell, as suggested by the Examiner at page 4, ¶ 2, lines 5-7 of the Final Rejection;
- The device for holding a bucket of chum as taught by Tetenes and modified by Nelson *et al.* can be further modified to have added thereto the sheet material having a longitudinal area for fabricating the toroidal sleeve as taught by Juergens, as suggested by the Examiner at page 5, ¶ 1, lines 1-4 of the Final Rejection;
- The device for holding a bucket of chum as taught by Tetenes and modified by Nelson *et al.*, Levey, Campbell, and Juergens can be further modified to have added thereto the toroidal sleeve being fabricated by stitching a first and second longitudinal edges of the longitudinal area together as taught by Roberts, as suggested by the Examiner at page 5, ¶ 2, lines 6-9 of the Final Rejection;
- The device for holding a bucket of chum as taught by Tetenes and modified by Nelson *et al.*, Levey, Campbell, Juergens, and Roberts can be further modified to have added thereto the sheet material being made of a flexible material as taught by Nelson *et al.* and Roberts, as suggested by the Examiner at page 5, ¶ 3, lines 3-6 of the Final Rejection;

- The device for holding a bucket of chum as taught by Tetenes and modified by Nelson *et al.* can be further modified to have added thereto the orifice in the bottom of the container permitting chum matter to pass through as taught by Willinger, as suggested by the Examiner at page 6, ¶ 2, lines 5-8 of the Final Rejection;
- The device for holding a bucket of chum as taught by Tetenes and modified by Nelson *et al.* and Willinger can be further modified to have added thereto the circular bottom component permanently attached to the container as taught by Roberts, as suggested by the Examiner at page 6, ¶ 3, lines 6-9 of the Final Rejection;
- The device for holding a bucket of chum as taught by Tetenes and modified by Nelson *et al.*, Willinger, and Roberts can be further modified to have added thereto the welting sewn between the bottom portion and the lower edge of the cylindrical container as taught by Campbell, as suggested by the Examiner at page 7, ¶ 1, lines 5-8 of the Final Rejection; and
- The device for holding a bucket of chum as taught by Tetenes and modified by Nelson *et al.*, Willinger, Roberts, and Campbell can be further modified to have added thereto the sheet material made from plastic as taught by Nelson *et al.* and Roberts, as suggested by the Examiner at page 7, ¶ 2, lines 3-6 of the Final Rejection.

The Examiner has merely combined elements in a piecemeal manner in light of Tetenes' disclosure to show obviousness by using Tetenes' own specification as though it were prior art and in doing so has violated the basic mandate inherent in 35 U.S.C. § 103 as decided in *In re Kamm and Young*, 17 USPQ 298, where the Court held:

“The rejection here runs afoul of a basic mandate inherent in section 103 - that a piecemeal reconstruction of the prior art patents in the light of appellants’ disclosure shall not be the basis for a holding of obviousness.”[Emphasis added]

And, in *In re Stephens, Wenzl, and Browne*, 145 USPQ 656 (CCPA 1965), where the Court reversed a rejection on a combination of references and held:

“References may not be combined indiscriminately and with guidance from applicant’s disclosure to show that the claims are unpatentable.”[at 656] [Emphasis added]; and

“In our consideration of the record in light of appellants’ arguments, we find nothing which demonstrates that the examiner and the board erred in rejecting the claims. While we agree with appellants that references may not be combined indiscriminately and with guidance from appellants’ disclosure to show that claims are unpatentable, we think the combination of references here is proper and adequately suggests the structure appellants have

achieved.”[at 657][Emphasis added]

And, in *Panduit Corp. v. Burndy Corporation et al.*, 180 USPQ 498 (District Court, N.D. Illinois, E. Div.), where the Court held:

“[C]ombination * * * cannot be anticipated piecemeal by showing that elements are individually old.”[at 498] [Emphasis added]; and

“[C]ombination * * * cannot be anticipated piecemeal by showing that the various elements of the invention are individually old.”[at 505] [Emphasis added]

And, in *In re Antle*, 444 F.2d 1168, 1171-72, 170 USPQ 285, 287-88 (CCPA 1971) where the Court held warned against selection of prior art with hindsight.

Tetenes can cite, for example, two examples of the Examiner combining elements in a piecemeal manner in light of Tetenes’ disclosure to show obviousness by using Tetenes’ own specification as though it were prior art for motivation.

First, at page 3, ¶ 1, line 8 of the Final rejection, where it is disclosed:

“[T]o completely enclose the inside of the container * * *.”

Tetenes has exhausted the use of this — in not so many words — throughout his application, for example, at page 7, line 11, where it is disclosed:

“[C]aptivating the bucket **12**
of chum **14** held within the
device **10**.”

And, second at page 4, ¶ 1, lines 7-8 of the Final rejection, where it is disclosed:

[T]he chum can pass through
the container walls and into
the water to attract fish.”

Tetenes has exhausted the use of this — in not so many words — throughout his application, for example, at page 7, ¶ line 24, where it is disclosed:

“[F]or permitting chum
matter to pass through * * *.”

Furthermore, it is apparent that the Examiner has taken facts beyond the record by stating at page 3, ¶ 2, lines 3-4 of the Final rejection a statement that is contrary to the PTO policy in *MPEP* § 706.02(a) directing Examiners never to overlook the importance of allowing claims that properly define patentable subject matter:

“It is inherent that the
cylindrical containers are
made of sheet material since
the thickness of the walls of
the container are so thin.”
[Emphasis added]

It is improper, if not inequitable, for the Examiner to rely on this fact for evidence of the rejection, as was decided in *In re Howard*, 394 F.2d 869 (CCPA 1968), where the Court held:

"I do not see how, without any evidence, we can use the doctrine of judicial notice to find that a system exists which anticipates that of the application or is nearly like it as to make the application an obvious variation * * *.

Without some concrete evidence (of which there is none) I do not think that it is possible to find that the system of this application is old or that it is obvious under Section 103."[at 872]
[Emphasis added]

And, in *In re Ahlert*, 165 USPQ 418, 420 (CCPA 1970), where the Court held:

"Facts beyond the record should not be evidence upon which a rejection is based." [Emphasis added]

Furthermore, the Examiner is not obligated to find such a rejection simply to be able to reject every claim in the application. Just because "the walls of the container are supposedly so thin" does not prove that "the cylindrical containing component is fabricated out of sheet material." Many thin materials are not sheet material. For example, items can be molded to be thin. Item can be cut to be thin. Items can be beat to be thin. Without a specific disclosure, no one can really know how something became thin.

If the Board still maintains such a rejection, Tetenes respectfully requests that the Board direct the Examiner to provide a reference that shows this feature of claim 1 as required by *MPEP* § 706.02(a), *In re Ahlert*, *In re Howard*, discussed above and *In re Newell*, 13 USPQ.2d 1248 (CAFC 1989), where the Court held:

"Without such concrete evidence neither the applicant nor the Examiner can make a proper determination of the state of the art or the issues relevant to either anticipation or obviousness, nor can the applicant fairly judge whether the prior art discloses the claimed invention, is capable of being combined with the other references, or is in an analogous field of art."
[Emphasis added]

Or an affidavit detailing the Examiner's knowledge as one of ordinary skill in the art to which the present invention pertains affirming that "It is inherent that the cylindrical containers are made of sheet material since the thickness of the walls of the container are so thin."[Emphasis added] as required by *37 CFR* § 1.107(b), where it is ruled:

"When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the

applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.”
[Emphasis added]

Again, it is apparent that the Examiner has taken facts beyond the record by stating at page 3, ¶ 2, lines 8-9 of the Final rejection a statement that is again contrary to the PTO policy in *MPEP* § 706.02(a) directing Examiners never to overlook the importance of allowing claims that properly define patentable subject matter:

“It is inherent that the side walls are stitched together since that is how components were attached to the container * * *.”[Emphasis added]

Again, it is improper — if not inequitable — for the Examiner to rely on this fact for evidence of the rejection as was decided in *In re Howard* and *In re Ahlert* discussed above.

Furthermore, again the Examiner is not obligated to find such a rejection simply to be able to reject every claim in the application.

If the Board still maintains such a rejection, Tetenes respectfully requests that the Board again direct the Examiner to provide a reference that shows this feature of claim 1 as required by *MPEP* § 706.02(a), *In re Ahlert*, *In re Howard*, and *In re Newell* discussed

above or an affidavit detailing the Examiner's knowledge as one of ordinary skill in the art to which the present invention pertains affirming that "It is inherent that the side walls are stitched together since that is how components were attached to the container * * *."

[Emphasis added] as required by 37 CFR § 1.107(b) discussed above.

D. Conclusions.

In view of the arguments presented throughout the instant Brief on Appeal, Tetenes respectfully submits that the Examiner's grounds for the rejection of claims 1 and 4 as being unpatentable under 35 U.S.C. § 103(a) over Tetenes in view of Nelson *et al.* Levey in view of Campbell in view of Juergens in view of Roberts and Willinger are no longer applicable and Tetenes therefore respectfully requests that the Board reverse this rejection.

Tetenes has shown that there is no motivation to modifying the device for holding a bucket of chum as taught by Tetenes can be modified to have added thereto the drawstring to close the upper edge of the container as taught by Nelson *et al.*, the device for holding a bucket of chum as taught by Tetenes and modified by Nelson *et al.* can be further modified to have added thereto the sheet material having a plurality of orifices for permitting chum matter to pas through as taught by Levey, the device for holding a bucket of chum as taught by Tetenes and modified by Nelson *et al.* can be further modified to have added thereto the sheet material having a second plurality of orifices to thread the drawstring as taught by Campbell, the device for holding a bucket of chum as taught by

Tetenes and modified by Nelson *et al.* can be further modified to have added thereto the sheet material having a longitudinal area for fabricating the toroidal sleeve as taught by Juergens, the device for holding a bucket of chum as taught by Tetenes and modified by Nelson *et al.*, Levey, Campbell, and Juergens can be further modified to have added thereto the toroidal sleeve being fabricated by stitching a first and second longitudinal edges of the longitudinal area together as taught by Roberts, the device for holding a bucket of chum as taught by Tetenes and modified by Nelson *et al.*, Levey, Campbell, Juergens, and Roberts can be further modified to have added thereto the sheet material being made of a flexible material as taught by Nelson *et al.* and Roberts, the device for holding a bucket of chum as taught by Tetenes and modified by Nelson *et al.* can be further modified to have added thereto the orifice in the bottom of the container permitting chum matter to pass through as taught by Willinger, the device for holding a bucket of chum as taught by Tetenes and modified by Nelson *et al.* and Willinger can be further modified to have added thereto the circular bottom component permanently attached to the container as taught by Roberts, the device for holding a bucket of chum as taught by Tetenes and modified by Nelson *et al.*, Willinger, and Roberts can be further modified to have added thereto the welting sewn between the bottom portion and the lower edge of the cylindrical container as taught by Campbell, and the device for holding a bucket of chum as taught by Tetenes and modified by Nelson *et al.*, Willinger, Roberts, and

Campbell can be further modified to have added thereto the sheet material made from plastic as taught by Nelson *et al.* and Roberts.

11. Table of Authorities.

| | |
|--|--------|
| <i>37 CFR § 1.107(b)</i> | 23, 25 |
| <i>37 CFR § 1.192(c)(1)</i> | 5 |
| <i>37 CFR § 1.192(c)(2)</i> | 5 |
| <i>Arkie Lures, Inc. v. Gene Larew Tackle, Inc.</i> , 912 F.Supp. 422, 38 USPQ.2d 1300 (W.D.Ark. 1996) | 14 |
| <i>Gambro Lundia AB v. Baxter Healthcare Corporation</i> , 110 F.3d 1573, 42 USPQ.2d 1378 (Fed. Cir. 1997) | 14 |
| <i>Gardner V. TEC Sys. Inc.</i> , 725 F.2d 1338, 1344, 220 USPQ 777, 782 (Fed. Cir. 1984) | 11 |
| <i>Graham v. John Deere Co.</i> , 383 U.S. 1, 17, 148 USPQ 459, 467, 15 L.Ed. 2d 545, 86 S. Ct. 684 (1966) | 11, 16 |
| <i>Great A. & P. Tea Co. v. Supermarket Equip. Co.</i> , 340 U.S. 147, 155, 87 USPQ 303, 309 (1950) | 10 |
| <i>Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.</i> , 21 F.3d 1068, 30 USPQ.2d 1377 | 16 |
| <i>In re Ahlert</i> , 165 USPQ 418, 420 (CCPA 1970) | 22-24 |
| <i>In re Antle</i> , 444 F.2d 1168, 1171-72, 170 USPQ 285, 287-88 (CCPA 1971) | 20 |
| <i>In re Deuel</i> , 51 F.3d 1552, 1557, 34 USPQ.2d (BNA) 1210, 1214 (Fed. Cir. 1995) ... | 10 |
| <i>In re Donaldson Co.</i> , 16 F.3d 1189, 1192, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (en banc) | 11 |
| <i>In re Fine</i> , 837 F.2d 1071, 5 USPQ.2d 1596 (Fed. Cir. 1988) | 16 |
| <i>In re Fritch</i> , 922, F.2d 1260, 23 USPQ.2d 1780 | 14-16 |

| | |
|--|------------|
| <i>In re Gordon</i> , 733 F.2d at 902, 221 USPQ at 1127 | 15 |
| <i>In re Howard</i> , 394 F.2d 869 (CCPA 1968) | 21, 23, 24 |
| <i>In re Jones</i> , 958, F.2d 347, 21 USPQ.2d 1941 | 12, 16 |
| <i>In re Kamm and Young</i> , 17 USPQ 298 | 18 |
| <i>In re Keller</i> , 642 F.2d 413, 208 USPQ 871 (CCPA 1981) | 16 |
| <i>In re Merck & Co., Inc.</i> , 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986) | 16 |
| <i>In re Newell</i> , 13 USPQ.2d 1248 (CAFC 1989) | 23, 24 |
| <i>In re Stephens, Wenzl, and Browne</i> , 145 USPQ 656 (CCPA 1965) | 19 |
| <i>In re Vaeck</i> , 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991) | 10 |
| <i>In re Woodruff</i> , 919 F.2d 1575, 1577, 16 USPQ2d 1934, 1935 (Fed. Cir. 1990) | 10 |
| <i>MPEP</i> § 706.02 | 11 |
| <i>MPEP</i> § 706.02(a) | 21, 23, 24 |
| <i>Panduit Corp. v. Burndy Corporation et al.</i> , 180 USPQ 498 (District Court, N.D. Illinois, E. Div.) | 20 |
| <i>Richardson-Vicks Inc. v. The Upjohn Co.</i> , 122 F.3d 1476, 44 USPQ.2d 1181 (Fed. Cir. 1997) | 10 |
| <i>Texas Instruments Inc. v. Unit States Int’l Trade Comm’n</i> , 988 F.2d 1165, 1178, 26 USPQ2d 1018, 1028 (Fed. Cir. 1993) | 11 |

12. List of References.

United States Patent Number 1,841,956 to Juergens

United States Patent Number 2,377,311 to Campbell

United States Patent Number 2,603,028 to Roberts

United States Patent Number 3,499,526 to Willinger

United States Patent Number 4,890,413 to Nelson *et al.*

United States Patent Number 4,903,429 to Tetenes

United States Patent Number 5,617,669 to Levey

13. Appendix.

- 1 1. A device for holding a bucket of chum submerged in water, comprising:
 - 2 a) a cylindrical containing component having a lower edge and an upper edge;
 - 3 b) a circular bottom component being permanently attached to said lower
4 edge of said cylindrical containing component;
 - 5 c) a toroidal sleeve being fixedly located near said upper edge of said
6 cylindrical containing component;
 - 7 d) a drawstring cooperating with said upper edge of said cylindrical
8 containing component and pulling said upper edge closed for captivating
9 the bucket of chum held within said device; and
 - 10 e) a welting having edges;
- 11 wherein said cylindrical containing component is fabricated out of sheet material;
- 12 wherein said sheet material is rectangular and has an upper edge, a lower edge, and
13 two side edges;
- 14 wherein said upper edge of said sheet material is said upper edge of said cylindrical
15 containing component;
- 16 wherein said lower edge of said sheet material is said lower edge of said cylindrical
17 containing component;
- 18 wherein said sheet material has two side edges that are stitched together;

19 wherein said sheet material has a first plurality of orifices therein for permitting
20 chum matter to passthrough;
21 wherein said sheet material has a second plurality of orifices inline therein for
22 cooperating with said drawstring that is threaded therethrough;
23 wherein said sheet material has a longitudinal area extending between said first
24 plurality of orifices and said second plurality of orifices, fabricates said toroidal
25 sleeve, and has a first longitudinal edge and a second longitudinal edge;
26 wherein said toroidal sleeve is fabricated by attaching said first longitudinal edge of
27 said longitudinal area and said second longitudinal edge of said longitudinal area
28 together;
29 wherein said sheet material is flexible plastic material;
30 wherein said circular bottom component is fabricated out of sheet material having
31 at least one orifice therein for permitting the chum matter to pass through;
32 wherein said circular bottom component has a circumference and is permanently
33 attached by stitching near said circumference thereof and near said lower edge of
34 said cylindrical containing component;
35 wherein said edges of said welting are sewn in between said circumference of said
36 circular bottom component and said lower edge of said cylindrical containing
37 component; and
38 wherein said sheet material is flexible plastic material.

1 4. The device as defined in claim 1, wherein said toroidal sleeve has foam floatation
2 element housed therein.